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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,163	12/15/2003	John Kolbjoern Roedseth	DN2003204	4406

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THE GOODYEAR TIRE & RUBBER COMPANY
INTELLECTUAL PROPERTY DEPARTMENT 823
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EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,163

Applicant(s)

ROEDSETH, JOHN KOLBJOERN

Examiner

Adrienne C. Johnstone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 16, and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-10 in the reply filed on June 21, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 11-15 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 21, 2006 (see paragraph 1 above).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the art exemplified by Boileau (3,830,273), Gerard et al. (5,421,390), Gerard et al. (5,645,658), Hammond et al. (5,685,927), and European Patent Application 0 465 786 A1, in view of Palmer (1,293,528), Murray (2,691,335), French Patent 607.026, and Japanese Patent Application 5-229303 A taken with Japanese Patent Application 5-229302 A.

These references are combined for the same reasons as set forth in paragraph 9 of the Office action mailed March 29, 2006. Specifically, the only difference between the prior art tire and the claimed tire is the positioning of the circumferentially extending ring in rather than under the circumferentially extending groove, as evidenced by Boileau (embodiment of the sole figure), Gerard et al. '390 (embodiment of Figure 1), Gerard et al. '658 (embodiment of Figure 1), Hammond et al. (embodiment of Figure 2), and European Patent Application 0 465 786 A1 (embodiments of Figures

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1-6) for example; however, both of these positions for such circumferentially extending rings are well known alternatives in the art, as evidenced by Palmer (embodiments of Figures 1 and 5), Murray (embodiments of Figures 1-7), French Patent 607.026 (embodiment of Figure 1, soft rubber D is optional, determined through oral translation), and Japanese Patent Application 5-229303 A (embodiment of the sole figure with translation) taken with Japanese Patent Application 5-229302 A (embodiment of Figure 2 with abstract) for example. It would therefore have been obvious to one of ordinary skill in the art to provide such well known alternative positioning of the circumferentially extending ring in rather than under the circumferentially extending groove in the above prior art tire. As to claim 3, Gerard et al. '390 discloses an exemplary groove depth of 24 mm in a tire having a section height of 106 mm (23% of the tire section height). As to claims 6 and 7, the prior art tire may have a plurality of the circumferentially extending grooves having the circumferentially extending ring (Boileau col. 1 line 62 - col. 3 line 8; Gerard et al. '390 col. 1 line 33 - col. 3 line 11; Hammond et al. col. 2 line 41 - col. 3 line 40).

Applicant argues that there is not a reasonable expectation of success in making the proposed combination, but this is not the case: contrary to applicant's arguments, one of ordinary skill in the art would not expect the positioning of the circumferentially extending ring in rather than under the circumferentially extending groove to interfere with the function of the above-noted prior art tire, and applicant has not yet provided evidence supporting the argument of a lack of reasonable expectation of success (MPEP 2143.02). Note that the newly added limitation of the circumferentially extending ring being "separately manufactured" is a process limitation which does not require any structure in the claimed tire other than what is already present in the combination proposed by the examiner (applicant is not yet claiming that the ring is not bonded to the underlying groove surface, which may make the argument persuasive but may not be supported by the original

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disclosure in this application). For example, in Boileau the purpose of the circumferentially extending ring 7 is to reinforce the connection 6, which it will do whether in or under the groove formed by the connection 6 without significantly changing tire properties as long as it remains bonded to the underlying groove surface.

As to claim 17, see the reinforcement wire 7 in the Figure 1 embodiment of Gerard et al. '390 and the reinforcement ring 7 in the Figure 1 embodiment of Gerard et al. '658. As to applicant's argument with respect to French Patent 607.026, see p. 2 lines 10-14: the space between elements A and B *will be capable of including the soft rubber D and in other respects the space forms a large anti-skid groove.*

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the art exemplified by Boileau (3,830,273), Gerard et al. (5,421,390), Gerard et al. (5,645,658), Hammond et al. (5,685,927), and European Patent Application 0 465 786 A1, in view of Palmer (1,293,528), Murray (2,691,335), French Patent 607.026, and Japanese Patent Application 5-229303 A taken with Japanese Patent Application 5-229302 A as applied to claims 1-9 and 17 above, and further in view of Japanese Patent Application 8-318715 A and German Utility Model DE 296 07 231 U1.

These references are combined for the same reasons as set forth in paragraph 10 of the Office action mailed March 29, 2006. Specifically, it is well known to provide reflective or fluorescent material in tread grooves in order to improve safety, as evidenced by Japanese Patent Application 8-318715 A (abstract, figures) and German Utility Model DE 296 07 231 U1 (abstract, figures) for example; it would therefore have been obvious to one of ordinary skill in the art to provide the circumferentially extending rings in the circumferentially extending grooves of the above tire with such well known reflective or fluorescent material in order to improve safety.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the art exemplified by Boileau (3,830,273), Gerard et al. (5,421,390), Gerard et al. (5,645,658), Hammond et

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al. (5,685,927), and European Patent Application 0 465 786 A1, in view of Palmer (1,293,528), Murray (2,691,335), French Patent 607.026, and Japanese Patent Application 5-229303 A taken with Japanese Patent Application 5-229302 A as applied to claims 1-9 and 17 above, and further in view of Published PCT Application 95/18022 A1 or, alternatively, further in view of Japanese Patent Application 2003-335109 A.

PCT '022 teaches to provide the outer surface of rings inside tread grooves with a grooving pattern in order to inhibit water from collecting inside the grooves and therefore inhibit hydroplaning by promoting water flow (description p. 5 lines 11-24, p. 16 lines 1-3, and p. 22 Example 1). Alternatively, JP '109 teaches to provide the outer surface of rings inside tread grooves with a grooving pattern in order to reduce noise generation (abstract, figures). It would therefore have been obvious to one of ordinary skill in the art to provide the outer surface of rings inside tread grooves with a grooving pattern in order to inhibit water from collecting inside the grooves and therefore inhibit hydroplaning by promoting water flow or, alternatively, in order to reduce noise generation.

Response to Arguments

7. In response to applicant's argument that each of the secondary references is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the secondary references are all directed to pneumatic tires and are all showing alternative ways of providing a circumferentially extending ring in or under a circumferentially extending groove.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. British Patent Specification 15,002 discloses another example of the prior art tire having the alternative positioning of the circumferentially extending ring in or under the circumferentially extending groove.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571) 272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adrienne C. Johnstone
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Adrienne C. Johnstone', written over a horizontal line.

Adrienne Johnstone

September 3, 2006